

### **REMARKS/ARGUMENTS**

The Examiner is thanked for the clarity and conciseness of the Office Action, and for the citation of references, which have been studied with interest and care.

This Amendment is in response to the Office Action mailed January 26, 2005. In the Office Action, claims 1-54 stand rejected under the judicially created doctrine of obviousness-type double patenting and claims 1-14, 19-32, and 37-50 under 35 U.S.C. § 102.

Applicant has amended independent claims 1, 19, and 37 to further clarify the embodiments of the invention.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

#### ***Double Patenting***

Claims 1-54 stand rejected under the judicially created doctrine of the obviousness-type double patenting of the claim in United States Patent No. 6,740,803.

In response, Applicant respectfully submits herewith a Terminal Disclaimer in compliance with 37 CFR 1.321(c), which is attached to this Response. Applicant believes that this rejection is now moot and respectfully requests withdrawal of this ground for rejection.

#### ***Rejection Under 35 U.S.C. § 102***

Claims 1-14, 19-32, and 37-50 stand rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 6,426,455 issued to Hasegawa (hereinafter Hasegawa).

MPEP § 2131 provides:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference.” *Verdegaal Bros. V. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... “The *identical invention* must be shown in as complete detail as contained in the ... claim.” (Emphasis added).

*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim.

Applicant respectfully submits that amended independent claims 1, 19, and 37 are not anticipated by Hasegawa, because Hasegawa does not teach each and every element as set forth in the claims, as arranged in the claims, nor does Hasegawa teach the identical invention. In fact, Hasegawa is related to a very different invention.

As set forth in the Office Action, as allegedly anticipating Applicant's original independent claims, the Office Action cites the Abstract which states that:

"The fee for practicing to play a musical instrument is charged on a user so that the user may practice to play the musical instrument with eagerness when the user practices to play the musical instrument using a terminal device that can be connected to a server...A terminal device 10 can be connected to a server via a network NW. A keyboard instrument 26 is connected to the terminal device 10, and the user practices to play the musical instrument with the use of the keyboard instrument 26...Practice information representing the state of the users practicing to play the musical instrument is transmitted to server 30 to be stored within server 30. Server 30 determines the fee for the users playing practice and the fee for materials used for practicing to play by discounting the fees in accordance with the practice information, and charges the determined fees on the user..." (Abstract, emphasis added).

Thus, Hasegawa is related to the transmission of "practice information" related to a user's practicing for the determination of fees and to encourage a user to practice.

In contrast thereto, and as set forth in Applicant's amended independent claims 1, 19, and 37, Applicant's claim limitations relate to: in response to a user selecting a musical piece, transmitting *a session file associated with the musical piece*, the session file *including an audio file and multimedia data*...processing the session file utilizing a computing device *to present a multimedia presentation of the audio file to the user*...coupling the musical instrument to the computing device by performing *analog to digital conversion of the musical instrument's analog signal such that an analog audio signal for the musical instrument generated responsive to a user actually playing the musical instrument is converted into a digitized audio signal*...and...*creating a mixed digital signal that combines the digitized audio signal from the*

*musical instrument with the audio file...the mixed digital signal being transmitted through a sound device such that the user can play the musical instrument in conjunction with the multimedia presentation of the audio file.*

Thus, the embodiments of Applicant's invention are very different than that disclosed in the Hasegawa reference. In particular, contrary to the Office Action's assertion, Applicant can find no teaching or suggestion of transmitting a session file associated with the musical piece, in which the *session file includes an audio file and multimedia data*. The Examiner cites the Abstract, Figure 1, and column 5, lines 56-column 6, line 2, for this teaching. However, Applicant cannot particularly find this teaching or suggestion. Applicant respectfully requests that the Examiner particularly cite the text for this teaching.

Looking particularly at column 5, line 56-column 6, line 2, this section of the Hasegawa patent states:

"Next, the user purchases a product needed for the playing practice. In this case, purchase controlling section 103 informs server 30 of the teaching material (product) that the user wishes to purchase, in accordance with the user's instruction using keyboard 18 and mouse 19. In server 30, sale controlling section 203 presents the teaching materials stored in the teaching material (product) storing section 213 together with the fees for the teaching materials to terminal device 10. The presented teaching materials and fees are displayed on display 22. Here, the teaching materials herein referred to are, for example, subprograms started on the playing-practice program to be used for the playing practice, MIDI data of the music for practice that is used for the playing practice, music score data for printing, and others." (Emphasis Added).

Thus, Hasegawa teaches that a user purchases a teaching material product and that teaching materials refer to subprograms started on the playing-practice program to be used for playing practice, MIDI data of the music for practice that is used for playing practice, music score data for printing, and others.

Applicant respectfully submits that there is no specific teaching or suggestion of a session file associated with a musical piece *that includes an audio file and multimedia data and that this*

*session file is processed by the computing device to present a multimedia presentation of the audio file to the user.*

Moreover, nowhere does Hasegawa teach or suggest coupling a musical instrument to the computing device by performing analog to digital conversion of the *musicals instrument's analog audio signal* such that *an analog audio signal from the musical instrument generated responsive to a user actually playing the musical instrument* is converted into a digitized audio signal...and...*creating a mixed digital signal that combines the digitized audio signal from the musical instrument with the audio file...the mixed digital signal being transmitted through a sound device such that a user can play the musical instrument in conjunction with the multimedia presentation of the audio file.*

In contrast, as shown in Figures 2 and 3 of Hasegawa, and the explanatory text included in column 7, line 54-column 8, line 34, only a keyboard instrument 26 is disclosed that transmits MIDI data to a MIDI interface. Utilizing a MIDI interface for receipt of MIDI digitized data is a requirement of Hasegawa.

There is absolutely no teaching or suggestion in Hasegawa of taking *an original analog audio signal from a musical instrument that is generated in response to a user actually playing the analog musical instrument*, converting that signal into a digitized audio signal, and then *creating a mixed digital signal that combines the digitized audio signal from the musical instrument with the audio file*, and further transmitting the mixed digital signal through a sound device such that a user can play a musical instrument (that originally produces a real actual analog audio signal) in conjunction *with a multimedia presentation of an audio file.*

Quite simply, Hasegawa does not teach each and every limitation as arranged in Applicant's amended independent claims 1, 19, and 37, nor does it teach the "identical invention", therefore anticipation is not present.

Applicant respectfully requests that independent claims 1, 19, and 37 be allowed and passed to issuance as well as the dependent claims therefrom.

***Conclusion***

In view of the remarks made above, it is respectfully submitted that pending claims 1-54 define the subject invention over the prior art of record. Thus, Applicant respectfully submits that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 5/26/2005

By

William Alford

Reg. No. 37,764

Tel.: (714) 557-3800 (Pacific Coast)

Attachments

12400 Wilshire Boulevard, Seventh Floor  
Los Angeles, California 90025

---

**CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.8A)**

*I hereby certify that this correspondence is, on the date shown below, being:*

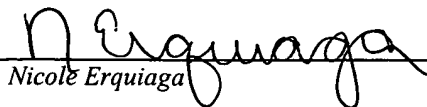
**MAILING**

☒ deposited with the United States Postal Service  
as first class mail in an envelope addressed to:  
Commissioner for Patents, PO Box 1450,  
Alexandria, VA 22313-1450.

Date: 5/26/2005

**FACSIMILE**

☐ transmitted by facsimile to the Patent and  
Trademark Office.

  
Nicole Erquiaga

5/26/2005

Date